

Since no claims are amended, added or canceled by this Response, the claims of this application as they presently stand are not reproduced herein. Claims 1-20 were present in this application as originally filed. Accordingly, the claims currently under active prosecution in this application are Claims 1-20.

In the currently outstanding Official Action, the Examiner has:

1. Acknowledged Applicants' claim for foreign priority under 35 USC 119 (a) – (d) or (f), and confirmed the receipt by the United States Patent and Trademark Office of the required certified copies of the priority document therefor;
2. Indicated that the drawings originally filed as part of this application have been accepted;
3. Provided Applicants with copies of the Forms PTO-1449 filed with their Information Disclosure Statements in this application, respectively, duly signed, dated and initialed by the Examiner to confirm his consideration of the art listed therein;
4. Provided Applicants with a copy of a Form PTO-892 listing the references cited by him;
5. Rejected Claims 1-20 under 35 USC 103(a) as being unpatentable over the Ohki, et al. reference (US Patent 6,636,647) in view of the Hart et al reference (US Patent 5,694,494).

Further comment on items 1-4 above is not deemed to be necessary in this Response.

With respect to item 5 above, Applicant respectfully traverses the Examiner's rejection of Claim 1-20 and requests reconsideration.

The basis of Applicant's traversal of the Examiner's outstanding rejection of all of the presently pending claims is that Applicant respectfully submits that the present invention as herein claimed would not have been obvious under the terms of 35 USC 103(a) to one of ordinary skill in the art at the time that the present invention was made.

More particularly, Applicant respectfully submits that the Examiner has failed to recognize that his own characterization of the Ohki reference is indicative of the difference between the present invention and that reference. Thus, although the Ohki reference describes extracting image features using a mask image, it will be understood that the Ohki reference is characterized in that by superimposing a mask image on an area where two image data overlap each other, the features of the two images are extracted and thereafter are merged in a natural looking manner.

In contrast, the present invention is characterized in that by superimposing a mask image on one image data read from a predetermined form in which data has been entered by handwriting, the handwritten part is extracted as data.

Therefore, Applicant respectfully submits that when the appropriate criteria for the establishment of a *prima facie* case of obviousness are applied to the Ohki reference, it will be readily understood that a person of ordinary skill in the art at the time that the present invention was made would not be lead to the presently claimed invention from a consideration of the Ohki construction. Rather, it is only through a consideration of the Applicant's specification that the present invention becomes apparent to one skilled in the art even assuming knowledge of the Ohki reference, i.e., it is only via improper hindsight reasoning that one of ordinary skill in the art would reach the present invention with or without the teachings of the Ohki reference before him.

It will be recalled in the above regard that the criteria for the establishment of a *prima facie* case of unpatentability under 35 USC 103(a) are set forth in the MPEP as follows:

To establish a *prima facie* case of obviousness under Section 103, Title 35 United States Code (35 US §103), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2D 1438 (Fed. Cir. 1991). (See, Manual of Patent Examining Procedure §2142 (8th Edition), at page 2100-2121, *et seq.*)

Furthermore, it should be recognized that since Ohki aims at merging image data in a natural looking manner, it is considered to be impossible in the case of Ohki that the printing means as disclosed in present Claim 19 of this application would be used for printing out the data after superimposing the entered data extracted and the layout data stored previously.

Applicant also respectfully submits that the Hart reference is also inapposite to the present invention.

In particular, the Hart reference is characterized in that both an image of a form (first image) and an image that information has been added to the form (second image) are read out. Subsequently in Hart, the first image is subtracted from the second image so as to identify the added part. However, unlike the mask processing of the present invention, the Hart subtraction operation cannot delete the entire form unless the concentrations of the first and second images are the same (note the detail in the Hart specification concerning the comparison levels of each pixel utilized in arriving at the image of the added part). Thus, when the mask processing of the present invention is utilized, the predetermined form parts are completely deleted, while in the Hart reference this is only the case when the first and second image concentrations are substantially the same.

Hence, Applicant respectfully submits that the present invention is not obvious within the terms of 35 USC 103(a) over the Ohki reference, the Hart reference, or any combination of the Ohki and Hart references.

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In view of the foregoing Response to the currently outstanding Official Action, Applicants respectfully submit that all of the claims in the present application are in condition for allowance. A decision so holding and allowing Claims 1-20 in response to this communication is respectfully requested.

Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

Respectfully submitted,

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